

REMARKS / ARGUMENTS

I. General Remarks

Please consider the application in view of the following remarks. Applicants thank the Examiner for her careful consideration of this application.

II. Disposition of Claims

Claims 1-83 are pending in this application.

In the Final Office Action mailed December 8, 2006 ("the Final Office Action"), claims 1-83 were rejected under 35 U.S.C. § 102(e) and 35 U.S.C. § 102(a).

In this response, claims 1, 2, 5-7, 11, 12, 42, 43, 45-49, 51-53, 55, 64, 65, 67-71, 73-75, and 77 have been amended herein. These amendments are supported by the specification as filed, and by the applications to which the present application claims priority. In the Advisory Action, the Examiner indicated that the amendment filed by Applicants on February 7, 2007 ("the February 7, 2007 Amendment") was not entered because the amendments therein raised new issues that would require further consideration. (*See* Advisory Action at ¶ 3.) Therefore, Applicants have listed and amended the claims in this Response as they were pending prior to the filing of that amendment.

III. Rejections of Claims

A. Rejections of Claims Under 35 U.S.C. § 102(e)

Claims 1-83 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2003/0228985 by Taylor *et al.* ("US2003/0228985"). With respect to these rejections, the Final Office Action states:

US2003/0228985 discloses, with respect to all the claims, a method of treating a subterranean formation comprising: providing a gelled liquid hydrocarbon treatment fluid comprising a liquid hydrocarbon and a gelling agent that comprises a polyvalent metal salt of an organophosphonic acid ester or a polyvalent metal salt of an organophosphinic acid, and treating the subterranean formation with the gelled liquid hydrocarbon treatment fluid. See the entire document, especially paragraphs [0008-0021] and [0023-0057], claims 1-41, and examples 1-12.

(Final Office Action at ¶ 2.) In response to Applicants' previous arguments regarding these claims, the Final Office Action further states:

Applicant's arguments filed 9/21/06 have been fully considered but they are not persuasive. Applicant argues that since he claims

priority back to February 23, 2001, that neither of the cited references constitute prior art. When, in fact, the instant application is a continuation-in-part of the cited applications and the subject matter of the instant invention is not supported within either application. The subject matter including providing “a gelled liquid hydrocarbon . . . gelling agent that comprises a polyvalent metal salt of an organophosphonic acid ester or a polyvalent metal salt of an organophosphinic acid,” which is the crux of the invention, is new material and is given the benefit of the filing date of the instant application (1/28/2004). Therefore, the cited references constitute prior art in this application because the new material is not supported by the application with the 2/23/2001 filing date.

(Final Office Action at ¶ 4.)

In the February 7, 2007 Amendment, Applicants amended independent claims 1, 42, and 64 to require that the gelling agent comprise a polyvalent metal salt of an organophosphonic acid ester, and argued that, because Applicants claim priority for these claims from U.S. Patent Application Serial No. 09/792,165 (“the ‘165 Application”), the filing of which pre-dates *US2003/0228985*, *US2003/0228985* does not constitute prior art to Applicants’ claims. In response to this amendment, the Advisory Action states:

Applicant argues that the 09/792,165 application (US 6,544,934) provides support for “a polyvalent metal salt of an organophosphonic acid ester,” when there is no such mention of “organophosphonic” in the disclosure of the US patent. The US patent 6,544,934 appears to support a “phosphonic” acid ester instead. Further, the CIP application 10/409,240 supports the “phosphonic” terminology as well.

(Advisory Action at Continuation of 3.) In this response, Applicants have amended claims 1, 5-7, 42, 45-49, 51, 64, 67-71, and 73 to replace the term “organophosphonic” with the term “phosphonic”, which, as the Examiner notes in the Advisory Action, is supported in the parent ‘165 Application that pre-dates the effective date of *US2003/0228985*. Therefore, Applicants respectfully submit that *US2003/0228985* does not constitute prior art to Applicants’ claims, as amended herein, and Applicants respectfully request the withdrawal of the rejections over this reference.

B. Rejections of Claims Under 35 U.S.C. § 102(a)

Claims 1-83 stand rejected under 35 U.S.C. § 102(a) as being anticipated by European Patent Application Publication No. EP 1236863 by Taylor *et al.* ("EP1236863"). With respect to these rejections, the Final Office Action states:

EP 1236863 discloses, with respect to all the claims, a method of treating a subterranean formation comprising: providing a gelled liquid hydrocarbon treatment fluid comprising a liquid hydrocarbon and a gelling agent that comprises a polyvalent metal salt of an organophosphonic acid ester or a polyvalent metal salt of an organophosphinic acid, and treating the subterranean formation with the gelled liquid hydrocarbon treatment fluid. See the entire document, especially paragraphs [0001-0035] claims 1-14, and examples 1-10.

(Final Office Action at ¶ 3.) In response to Applicants' previous arguments regarding these claims, the Final Office Action further states:

Applicant's arguments filed 9/21/06 have been fully considered but they are not persuasive. Applicant argues that since he claims priority back to February 23, 2001, that neither of the cited references constitute prior art. When, in fact, the instant application is a continuation-in-part of the cited applications and the subject matter of the instant invention is not supported within either application. The subject matter including providing "a gelled liquid hydrocarbon...gelling agent that comprises a polyvalent metal salt of an organophosphonic acid ester or a polyvalent metal salt of an organophosphinic acid," which is the crux of the invention, is new material and is given the benefit of the filing date of the instant application (1/28/2004). Therefore, the cited references constitute prior art in this application because the new material is not supported by the application with the 2/23/2001 filing date.

(Final Office Action at ¶ 4.)

In the February 7, 2007 Amendment, Applicants amended independent claims 1, 42, and 64 to require that the gelling agent comprise a polyvalent metal salt of an organophosphonic acid ester, and argued that, because Applicants claim priority for these claims from U.S. Patent Application Serial No. 09/792,165 ("the '165 Application"), the filing of which pre-dates EP1236863, EP1236863 does not constitute prior art to Applicants' claims. In response to this amendment, the Advisory Action states:

Applicant argues that the 09/792,165 application (US 6,544,934) provides support for "a polyvalent metal salt of an

organophosphonic acid ester,” when there is no such mention of “organophosphonic” in the disclosure of the US patent. The US patent 6,544,934 appears to support a “phosphonic” acid ester instead. Further, the CIP application 10/409,240 supports the “phosphonic” terminology as well.

(Advisory Action at Continuation of 3.) In this response, Applicants have amended claims 1, 5-7, 42, 45-49, 51, 64, 67-71, and 73 to replace the term “organophosphonic” with the term “phosphonic”, which, as the Examiner notes in the Advisory Action, is supported in the parent '165 Application that pre-dates the effective date of *EP1236863*. Therefore, Applicants respectfully submit that *EP1236863* does not constitute prior art to Applicants' claims, as amended herein, and Applicants respectfully request the withdrawal of the rejections over this reference.

IV. No Waiver

All of Applicants' arguments and amendments are without prejudice or disclaimer. Additionally, Applicants have merely discussed example arguments sufficient to overcome the Examiner's § 102(e) and § 102(a) rejections. Other arguments may exist, and Applicants reserve the right to present these additional arguments in a later Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicants do not acquiesce to the Examiner's additional statements. The reasons discussed by Applicants are sufficient to overcome the § 102(e) and § 102(a) rejections.

SUMMARY AND PETITION FOR A ONE-MONTH EXTENSION OF TIME TO FILE THIS RESPONSE

In light of the above remarks, Applicants respectfully request entry of the amendments presented herein and reconsideration and withdrawal of the outstanding rejections. Applicants further submit that the application is now in condition for allowance, and earnestly solicit timely notice of the same. Applicants respectfully request that the Examiner issue an advisory action if the Examiner does not find the claims to be allowable in light of the amendments and remarks made herein. Should the Examiner have any questions, comments or suggestions in furtherance of the prosecution of this application, the Examiner is invited to contact the attorney of record by telephone, facsimile, or electronic mail.

The Advisory Action states that the time period for filing this reply expires on the later of the mailing date of the Advisory Action (March 1, 2007) and the date set forth in the Final Office Action (March 8, 2007). Applicants hereby petition under the provisions of 37

C.F.R. § 1.136(a) for a one-month extension of time to file this Response, extending the period for reply from March 8, 2007 to April 8, 2007.

The Commissioner is hereby authorized to debit the Deposit Account of Baker Botts L.L.P. Deposit Account No. 02-0383, Order Number 063718.1041, in the amount of \$120.00 for the fee under 37 C.F.R. § 1.17(a)(1) for the one-month extension of time to file this response. Should the Commissioner deem that any additional fees are due, including any fees for extensions of time, the Commissioner is authorized to debit Baker Botts L.L.P. Deposit Account No. 02-0383, Order Number 063718.1041, for any underpayment of fees that may be due in association with this filing.

Respectfully submitted,



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